REMARKS/ DISCUSSION OF ISSUES

In the present Amendment, Claims 22-24, 27, 29-31, 34, 36-38, and 41 have been amended. The limitations of Claims 28, 35, and 42 have been incorporated into independent claims 22, 29, and 36. No new matter has been added. Claims 22-27, 29-34, and 36-41 are pending.

I. Claim Rejection Under 35 U.S.C. § 103

A. Rejection of Claims 22-42 under 35 U.S.C. § 103(a)

In the present Office Action, Claims 22-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tormey et al.* (U.S. Application Pub. No. 2005/0071239 – hereinafter referred to as "*Tormey*") in view of *Greenwood* (U.S. Patent No. 6,675,212 – hereinafter referred to as "*Greenwood*"), in further view of *Lunenfeld* (U.S. Application Pub. No. 2005/0065996 – hereinafter referred to as "*Lunenfeld*"). After careful consideration of Examiner's rejection, Applicants assert that Claims 22-42, as now amended, are not rendered unpatentable by the combination of *Tormey*, *Greenwood*, and *Lunenfeld* in view of the arguments herein.

1. Rejection of independent Claims 22, 29, and 36

a. Scope and content of the prior art

Tormey discloses utilizing a web-based search engine and receiving a listing. *Tormey*, paragraph 5, lines 7-9 and Figure 1A, reference number 20, paragraph 43, lines 1-22, and paragraph 44, lines 1-2. *Tormey* also discloses allowing a user to elect the receipt of the search results via an e-mail message. *Tormey*, paragraph 83.

Greenwood discloses a system and method for improving data browsing efficiency in computer implemented data browsing systems. *Greenwood*, col. 3, lines 51-52. The invention enables automatic continuation of a data browsing session when a download of a requested data file is temporarily delayed. *Greenwood*, col. 3, lines 53-55. In particular, data requests are

monitored for excessive delay. *Greenwood*, col. 3, lines 55-57. The reasonable time frame for determining a temporary delay is separately programmable by the user. *Greenwood*, col. 7, lines 42-46. When the delay is identified as temporary, the download of the requested data file is handled by a separate monitoring task, set to run in the background, while active control of the data browsing session is returned to a user. *Greenwood*, col. 3, lines 58-62.

Lunenfeld discloses a client-server multitasking system and process for information and/or service retrieval from the same and/or different ones of servers substantially simultaneously and on-the-fly. The system uses the same and/or different queries of the same and/or different ones of the servers. In addition, the system sorts, groups, and/or organizes results from the servers, search engines, and/or sites, in accordance with instructions from requestors, and/or users, and/or instructions resident within the client-server multitasking system. *Lunenfeld*, abstract. The client-server multitasking system employs a "Timeout per Search Engine **329**", which is considered to be substantially the maximum time for a client making a search request to wait for each of the responses from the different servers which have been requested data. *Lunenfeld*, ¶[0422]. Notably, if the servers do not communicate responses to a requestor client within the timeout set by the Timeout per Search Engine **329**, the search requests of the non-responding servers may be cancelled by the requestor client. *Lunenfeld*, ¶[0423].

b. The claimed invention is distinguishable from the prior art

Applicants have amended Claim 22 (and similarly claims 29 and 36) to include the element of:

> "in response to activating said option, a data processing system waiting at least one user increment period within a user-predetermined timeout period, wherein said at least one user increment period is temporarily and dynamically adjusted in response to determining said communication program is deselected as a foreground task running on a data processing system;
> querying whether said first file is received before an expiration of said at least one user increment period;",

Support of the amendments can be found in the present Specification, at least in paragraph [0031], *et seq.* and Figure 3, reference numbers 304, 310, 312, and 314. Upon further review of Examiner's references, Applicants respectfully submit that nothing in the combination of

Tormey, *Greenwood*, and *Lunenfeld* discloses or suggests "in response to activating said option, a data processing system waiting at least one user increment period within a user-predetermined timeout period...", as recited in exemplary Claim 22.

Thus, it is important to emphasize that there are two distinct types of time periods in Applicants' claimed invention: (1) a user-predetermined timeout period, and (2) at least one user increment period within the user-predetermined timeout period. Support for the above assertion can be found in Applicants' application, paragraph [0033]:

> "Returning to block 304, if the option to forward response 132 to mail server 104 is detected, the process next moves to step 310, which depicts data processing system 102 waiting during a period, called a user increment, for receipt of response 132. The user increment is a length of time, *separate from* and generally shorter than, but potentially identical to the amount of time provided in response to timeout query 210." (emphasis added)

At most, the combination of *Tormey*, *Greenwood*, and *Lunenfeld* shows a system that enables a user to perform a search on a web-based search engine while monitoring for a timeout period whether a response to a data request has been received.

Neither *Tormey*, *Greenwood*, *Lunenfeld*, nor their combination teaches or suggests at least one user increment period within a user-predetermined timeout period. First, by Examiner's own acknowledgement, *Tormey* makes no explicit teaching of a time period, much less at least one user-incremented period or a timeout period (see page 3 of Office Action). Moreover, while *Greenwood* teaches a "reasonable time" frame to wait for a response (*Greenwood*, Col. 7, lines 29-46), such disclosure falls short of teaching or suggesting two separate time periods as recited in Applicants' amended claims: (1) a user-predetermined timeout period and (2) at least one user increment period within a user-predetermined timeout period.

Lastly, while *Lunenfeld* teaches a "Timeout (seconds) per Search Engine" (*Lunenfeld*, ¶¶[0487]-[0489]), *Lunenfeld* also fails to teach or suggest at least one user increment period within a user-predetermined timeout period, as recited in amended exemplary claim 22. However, it appears that Examiner is mischaracterizing paragraph [0489] of *Lunenfeld* as having two separate time periods. Paragraph [0489] of *Lunenfeld* states:

> "The **(i)** 'Timeout (seconds) per Search Engine' instructs the client C_n (16) and/or server PS (18) to return the typical user response UR_n (37)...within a period of less than the **(ii)** 'Timeout (seconds) per Search Engine' specified in the typical optional instructions $VJ_{n1}...VJ_{nk}$ (52)." (please note boldfaced italicized numbers **(i)** and **(ii)** have been added when referring to each of these portions of cited text described in *Lunenfeld* in the remarks below)

The Examiner is erroneously interpreting the teaching of *Lunenfeld because in* **(i)** and **(ii)**, only one "Timeout (seconds) per Search Engine" is defined and monitored for each search engine. The proper interpretation of the above quoted passage is that the timeout period **(i)** is set to at period that is less than the timeout period **(ii)** that is specified for typical optional instructions $VJ_{n1}...VJ_{nk}$ (52). Thus, timeout period **(ii)** is merely a guideline/instruction to define timeout period **(i)**, and not a separate time period that is measured (see *Lunenfeld*, ¶¶[0487] and [0489]). Moreover, even if one equated timeout period **(ii)** with the timeout period recited in claim 22, *Lunenfeld*'s timeout period **(ii)** is not user-predetermined, but rather it is instructed to the user/client C_n in *Lunenfeld*.

In addition Claim 22 (and similarly Claims 29 and 36) have been amended to further recite:

> "wherein said at least one user increment period is temporarily and dynamically adjusted in response to determining said communication program is deselected as a foreground task running on a data processing system;" and "querying whether said first file is received before an expiration of said at least one user increment period"

Examiner cites *Greenwood*, Col. 7, lines 16-27 and 42-64 as disclosing the recited element in amended exemplary Claim 22. The cited passage in *Greenwood*, lines 16-27, discloses:

> "For example, in one embodiment, the user can select and deselect an option that applies the monitoring step **302** universally to all data requests generated by the data browsing apparatus. In another exemplary embodiment, the user can individually select which data requests to which the monitoring step 302 is applied, such as by right clicking on a hyperlink, thereby opening a drop down menu that includes the two options, 'Open Link with Background Option' and 'Open Link in New Window with Background Option', or by clicking a special 'Background Refresh' button on a tool bar."

In amended Claim 22, whether the communication program temporarily and dynamically adjusts the at least one user increment period is determined by whether the communication program is deselected as a foreground task. However, in *Greenwood*, there is no temporary and

dynamic adjustment of "at least one user increment period" in response to a deselecting of the communication program as a foreground task. This temporal limitation is not taught or suggested in *Greenwood*.

c. Non-obviousness of the differences

Upon review of *Tormey*, *Greenwood*, and *Lunenfeld*, nothing in the combination would suggest to a person of ordinary skill in the art to employ creative states or inferences that would lead to Applicants' invention as recited in exemplary Claim 22. The result of the combination of *Tormey*, *Greenwood*, and *Lunenfeld* would be a system that enables a user to perform a search on a web-based search engine while enabling a user to receive a response to the search in the form of an e-mail response.

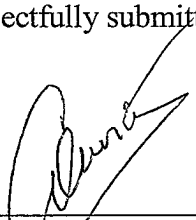
A person with ordinary skill in the art would not immediately see the connection between the expiry of the user-predetermined timeout period before the first file is received, the receipt of the file in the communication program and encapsulation of the file in a message transmission and send the message to a specified target address, once the file is received in the communication program ("in response to said user-predetermined timeout period expiring before said first file is received, and upon receipt of said first file by said communication program, said communication program encapsulating said first file in a message transmission and sending said message transmission to said mail server, wherein said mail server is responsive to a mail request by a mail client at a specified target address"), as recited in exemplary Claim 22. For example, *Lunenfeld* teaches away the idea of returning the file to a specified target address in response to a user-predetermined timeout period expiring before the file is received. Instead *Lunenfeld* teaches that requests that exceed a timeout period "may be then cancelled by the server PS (18) and/or clients $C_1 \ldots C_n$ (16)" (*Lunenfeld*, ¶[0423]). Cancelling the request for a file after a time has been exceeded, as taught be *Lunenfeld*, would run contrary to Applicants' recitation of returning a file requested by a mail client at a specified target address.

Therefore, in view of the aforementioned arguments, Applicants submit exemplary amended independent Claim 22, and similarly amended independent Claims 29 and 36 are not rendered unpatentable by the combination of *Tormey*, *Greenwood*, and/or *Lunenfeld* under 35 U.S.C. § 103(a). Moreover, Applicants submit that all dependent Claims 23-27, 30-34, and 37-41 are patentable at least by virtue of their dependence upon an allowable base claim 22, 29, or 36. Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM Corporation Deposit Account Number 09-0447**.

Respectfully submitted,



Carlos E. Amorín
Reg. No. 48,379
DILLON & YUDELL LLP
8911 North Capital of Texas Highway, Suite 2110
Austin, Texas 78759
512.343.6116

ATTORNEY FOR APPLICANTS